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TO: Commissioner for Patents

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F&L REF. NO.: 076507-0421


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Title of Documents Transmitted: Petition for Suspension of Rules Under 37 C.F.R. § 1.183
Amendment (Exhibit A)

Applicants: Baloga et al.
Serial No.: 10/026,964
Filed: December 21, 2001
Group Art Unit: 7993
F&L Ref. No.: 076507-0421

By: 
Name: Scott D. Anderson
Reg. No.: 46,521

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.


Scott D. Anderson

December 30, 2004
Date

DEC 30 2004

Appl. No. 10/026,964

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mark A. Baloga
Carl V. Forslund III
Thomas G. Feldpausch

Title: UTILITY DISTRIBUTION
SYSTEM

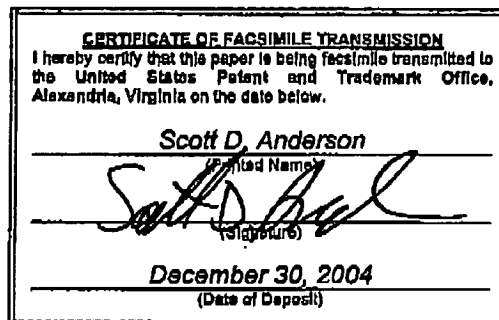
Appl. No.: 10/026,964

Filing Date: 12/21/2001

Examiner: Naoko N. Slack

Art Unit: 3635

Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R. § 1.183

The Applicants hereby petition for suspension of rules under 37 C.F.R. § 1.183 and request that the priority claim made and acknowledged by the PTO be conformed in the text of the present Application by amendment notwithstanding that the Issue Fee has been paid.

As grounds for this petition, the Applicants state as follows:

1. The applicable statute relating to a claim for priority (35 U.S.C. § 120) provides as follows (in pertinent part with emphasis added):

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, . . . which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed

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application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.

2. The applicable PTO rule relating to a claim for priority (37 C.F.R. § 1.78(a)(2)(i)) provides as follows (in pertinent part):

Except for a continued prosecution application filed under Sec. 1.53(d), any nonprovisional application . . . claiming the benefit of one or more prior-filed copending nonprovisional applications . . . must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) . . . and indicating the relationship of the applications.

3. On December 21, 2001, the present Application was filed containing a priority claim with the following text:

[0001] The present invention claims priority under 35 U.S.C. § 120 from copending U.S. Patent Application No. 09/183,023 titled "WORKSTATION" filed October 30, 1998, the full and entire disclosure of which is hereby incorporated herein by reference, and copending U.S. Patent Application No. 09/887,519 titled "MOVABLE DISPLAY SUPPORT SYSTEM" filed June 22, 2001, the full and entire disclosure of which is hereby incorporated herein by reference.

4. The transmittal stated that the present Application was a "Division" of U.S. Application No. 09/183,023 filed October 30, 1998 and of U.S. Application No. 09/887,519 filed on June 22, 2001.

5. The Filing Receipt mailed by the PTO on January 29, 2002 and an Updated Filing Receipt mailed by the PTO on March 21, 2002 both acknowledged the priority claim in the present Application and stated (correctly) as follows:

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A DIV OF 09/887,519 06/22/2001
AND A DIV OF 09/183,023 10/30/1998

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6. A non-final Office Action mailed by the PTO on December 5, 2002 and a non-final Office Action mailed by the PTO on June 3, 2003 stated as follows:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

7. A non-final Office Action mailed by the PTO on December 31, 2003 stated as follows:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

8. On September 30, 2004, the "Notice of Allowance and [Issue] Fee(s) Due" was mailed. On December 29, 2004, the Issue Fee was paid by the Applicants.

9. Application No. 09/183,023 to which priority has been claimed in the present Application issued as U.S. Patent No. 6,374,547 on April 23, 2002 (during the pendency of the present Application).

10. The Applicants request that the text of the application be conformed with the priority claim made and then acknowledged by the PTO in the Filing Receipt, Updated Filing Receipt, and Office Actions, and to reflect the issuance of U.S. Patent No. 6,374,547 from one of the priority applications. This petition has been filed within the period of time provided for payment of the Issue Fee.

11. The Applicants submit that there exists an extraordinary situation where justice requires that the requirement that an amendment (e.g., under 37 C.F.R. § 1.312) be filed before or with the payment of the Issue Fee (which is not a requirement of the statute) be suspended or waived by the Commissioner. The original claim for priority complies with 35 U.S.C. § 120 (and was acknowledged by the PTO on four separate occasions). This petition was filed one day following the payment of the Issue Fee. Justice requires that the amendment be made in the present Application to conform the text of the priority claim to M.P.E.P. § 201.11¹ and the present circumstances.

¹ The Applicants note that a clarifying revision of guidelines set forth in § 201.11 of the M.P.E.P. was made during the pendency of the present Application.

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12. The Applicants seek to conform the text of the present Application with the priority claim acknowledged by the PTO and the present circumstances (i.e., the issuance of a priority application as a patent) either:

- (a) by appropriate Examiner's amendment, or
- (b) by entry of the attached proposed amendment (Exhibit A).

This petition is accompanied by the proposed Amendment (Exhibit A) and the petition fee set forth in 37 C.F.R. § 1.17(h).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 12/30/04

By



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